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In re Application of
MUELLER et al. :
U.S. Application No. 10/527,212 :
PCT No.: PCT/EP03/09981 :
Int. Filing Date: 09 September 2003 : DECISION ON REQUEST
Priority Date: 18 September 2002 :
Attorney Docket No.: C 2341 PCT/US :
For: BOREHOLE TREATMENT AGENT :
CONTAINING LOW-TOXIC OIL PHASE :

This decision is issued in response to applicants' "Request for Correction of Inventorship" filed 31 March 2006, which is being treated as a Request under 37 CFR 1.497(d). The \$130 petition fee will be charged to Deposit Account no. 50-1177.

BACKGROUND

On 09 September 2003, applicants filed international application no. PCT/EP03/09981 which claimed a priority date of 18 September 2002. The international application named Heinz Mueller as applicant/inventor. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 March 2005.

On 10 March 2005, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 28 September 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 28 November 2005, applicants filed a declaration executed by: Heinz Mueller, Nadja Herzog; and Stephan Von Tapazicza.

On 10 March 2006, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration filed 28 November 2005 was defective because it indicated additional inventors not listed on the published international application.

On 31 March 2006, applicants filed the present "Request for Correction of Inventorship."

DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Nadja Herzog and Stephan Von Tapazicza to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17; and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

(4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the adding Nadja Herzog and Stephan Von Tapazicza to the application, applicants' 31 March 2006 submission satisfies requirements (1), (2), and (4).

However, item (3) has not been satisfied. Applicants have provided an "Consent of Assignee under 37 CFR 1.497(d)(3)" which states that assignee (Cognis Deutschland GmbH & Co. KG) consents to the correction of inventorship, however, the assignee has not established its ownership to the application in accordance with 37 CFR 3.73. (See Manual of Patent Examining Procedure (MPEP) §324 and Statement under 37 CFR 3.73(b). Therefore, applicants must provide a copy of the assignment or indicate that the assignment has been recorded in the United States Patent and Trademark Office (e.g., reel and frame number).

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b).

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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